

AF
JFW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/607,923
Filing Date	June 27, 2003
First Named Inventor	Bentivoglio, et al.
Art Unit	2875
Examiner Name	Ismael Negron
Attorney Docket Number	SCH-00069

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
---	--	--

Remarks

Applicant believes no fee to be due for the attached filing, however, should additional fees be due in order to prevent the abandonment of this application, please consider this as authorization to charge Deposit Account No. 501612 (Warn, Hoffmann, Miller & LaLone, P.C.) for any such fees due. A duplicate copy of this document is enclosed for this purpose.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Warn, Hoffmann, Miller & LaLone, P.C.		
Signature			
Printed name	Gregory L. Ozga		
Date	October 6, 2006	Reg. No.	53425

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Gregory L. Ozga	Date	October 6, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 10/607,923
Filing Date: June 27, 2003
Applicant: Bentivoglio et al.
Group Art Unit: 2875
Examiner: Ismael Negron
Title: PROXIMITY SENSOR FOR INTERIOR MIRROR
Attorney Docket: SCH-00069

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Sir or Madam:

This is a response and resubmitted Appeal Brief in response to the Notification of Non-Complaint Appeal Brief mailed on September 11, 2006 to which a timely one month response to due by October 11, 2006. Applicant respectfully requests reconsideration and entry of the resubmitted appeal brief.

REMARKS

The Examiner sent a Notification of Non-Compliant Appeal Brief that indicated that the Brief as previously submitted did not contain all of the proper headings. More specifically, Examiner maintains that the Appeal Brief that was

previously submitted did not contain an Evidence Appendix or a Related Proceedings Appendix. Applicant resubmits that attached Appeal Brief which now contains the Evidence and Related Proceedings Appendices. Entry of the attached Appeal Brief is respectfully requested.

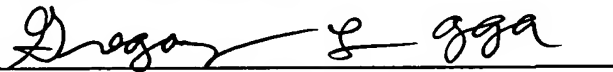
CONCLUSION

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain. Any needed extension of time is hereby requested with the filing of this document.

Respectfully submitted,

WARN, HOFFMANN, MILLER & LALONE, P.C.
Attorneys for Applicant(s)

Dated: *October 6, 2006*

By: 

Philip R. Warn, Reg. No. 32775
Gregory L. Ozga, Reg. No. 53425

P.O. Box 70098
Rochester Hills, MI 48307
(248) 364-4300

PRW:GLO:cah



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 10/607,923
Filing Date: June 27, 2003
Applicant: Bentivoglio et al.
Group Art Unit: 2875
Examiner: Ismael Negron
Title: PROXIMITY SENSOR FOR INTERIOR MIRROR
Attorney Docket: SCH-00069

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESUBMITTED APPEAL BRIEF

This is in response to the Examiner's Advisory Action Before the Filing of an Appeal Brief mailed December 28, 2005 rejecting claims 11-22. A Notice of Appeal was received by the Patent Office on January 19, 2006. The Appeal Brief is submitted in triplicate. Any needed extension of time is hereby requested with the filing of this document.

Table of Contents

	<u>Page</u>
Real Party in Interest	5
Related Appeals and Interferences.....	5
Status of Claims	5
Status of Amendments	5
Summary of the Claimed Subject Matter	5
Grounds of Rejection to be Reviewed on Appeal	6
Arguments	7
Whether Claims 11, 13-19 and 21 are rendered Obvious under 35 U.S.C. § 103(a)	7
Whether Claim 12 is rendered Obvious under 35 U.S.C. § 103(a).....	13
Whether Claim 20 is rendered Obvious under 35 U.S.C. § 103(a).....	14
Whether Claim 22 is rendered Obvious under 35 U.S.C. § 103(a).....	15
Appendix Contents	17
Claims Appendix	18
Evidence Appendix	21
Related Proceedings Appendix	25

Items in Appendix

Appendix A	Pending Claims of Application
Appendix B	Evidence Appendix containing Declaration of Volker Zipf
Appendix C	Related Proceedings Appendix

Table of Authorities

	<u>Page</u>
<i>In re Bond</i> 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990)	10
<i>In re Geiger</i> 815 F.2d at 688, 2 USPQ2d at 1278 (Fed Cir. 1987)	12
<i>In re Laskowski</i> 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989)	10
<i>In re Newell</i> 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989)	10
<i>Uniroyal, Inc. v. Rudkin-Wiley Corp.</i> 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988)	9
<i>In re Zirko</i> 111 F.3d 887, 42 USPQ 2d 1476 (Fed. Cir. 1997)	10, 12, 16

Real Party in Interest

The Real Party in Interest is Schefenacker Vision Systems Germany, GmbH & Co. KG, a German corporation, having a place of business at Eckenerstraße 2, 73730 Esslingen, Germany is the Assignee of Record, at Reel 014940, Frame 0641.

Related Appeals and Interferences

There are no related Appeals or Interferences in the subject application.

Status of Claims

In response to the Appellants response to Office Action mailed September 21, 2005, claims 1-10 and 23 were previously cancelled, pending claims 11-22 were finally rejected and are now currently the subject of this Appeal.

Status of Amendments

No Amendments have been filed in response to the Final Office Action.

Summary of the Claimed Subject Matter

A switch arrangement for an automotive interior mirror module (10) comprising a mirror housing (11) of an automotive interior mirror module (10). **Page 5 ¶ [0019].** At least one sensor (21, 25) disposed in said mirror housing (11). **Page 5 ¶ [0020], Figs 1-2.** An evaluation electronics unit (31, 35) disposed in said mirror housing (11) and operably associated with said at least one sensor (21). **Page 5 ¶ [0019-0020], Figs. 1-2.** The evaluation electronics unit (31) initiates at least one switching process based on the approach of a non

metallic object toward said at least one sensor (21). **Page 6 ¶ [0021]**. The evaluation electronics unit (31) generates a turn-on signal from a first approach and generates a turn-off signal from a second approach. **Page 6 ¶ [0021]**. At least one sensor (21, 25) is provided with a sensitivity adjustment that is used to set the length of the desired approach distance. **Page 4 ¶ [0012]**. At least one sensor (21,25) is located in the lower corner region of said housing (11) facing a driver. **Figs 1-2**.

Grounds of Rejection to be Reviewed on Appeal

1. Whether the combination of U.S. Patent No. 5,880,538 to Schulz (hereafter Schulz) in view of U.S. Patent No. 5,820,245 to Desmond (hereafter Desmond) are properly combinable to render claims 11, 13-19 and 21 obvious under 35 U.S.C. § 103(a).
2. Whether the combination of U.S. Patent No. 5,880,538 to Schulz (hereafter Schulz) in view of U.S. Patent No. 5,820,245 to Desmond (hereafter Desmond) are properly combinable to renders claim 12 obvious under 35 U.S.C. § 103(a).
3. Whether the combination of U.S. Patent No. 5,880,538 to Schulz (hereafter Schulz) in view of U.S. Patent No. 5,820,245 to Desmond (hereafter Desmond) are properly combinable to renders claim 20 obvious under 35 U.S.C. § 103(a).

4. Whether the combination of U.S. Patent No. 5,880,538 to Schulz (hereafter Schulz) in view of U.S. Patent No. 5,820,245 to Desmond (hereafter Desmond) are properly combinable to renders claim 22 obvious under 35 U.S.C. § 103(a).

Arguments

Whether Claims 11, 13-19 and 21 are rendered Obvious under 35

U.S.C. § 103(a)

Claim 11 was rejected under 35 USC §103(a) as being unpatentable over Schulz in view of Desmond. The final Office Action mailed on September 21, 2005 maintained that Schulz discloses all of the limitations of claim 11 **except for** the following:

- a mirror housing of an automotive interior mirror module (as recited in Claim 11);
- the sensor being disposed in the mirror housing (as recited in Claim 11);
- the electronic unit being disposed in the mirror housing (as recited in Claim 11);
- a reading lamp (as recited in Claim 13);
- the lamp being integrated in the housing (as recited in Claim 13);
- the lamp being turned on and off by the turn-on and turn-off signals (as recited in Claim 13);
- the automotive interior mirror module having a mirror base (as recited in Claim 14);
- the electronics unit being located in the mirror base (as recited in Claim 15);
- the electronics unit being an external unit located (as recited in Claim 16);
- the external unit being located generally from the mirror housing or the mirror base (as recited in Claim 16);
- the electronics unit being located in the housing (as recited in Claim 17);
- the sensor being a sensor array (as recited in Claim 18); and
- the sensor being located in the lower corner region of the housing facing the driver (as recited in Claim 22).

The Examiner relied upon Desmond to fill the numerous gaps left by Schulz. In conclusion, the final office action stated:

it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine to non-contacts which of SCHULZ and the vehicle illumination device of DESMOND, et al. to equip such illumination device with a switch capable of being operated by the approaching hand of an user, as per the teachings of SCHULZ (see column 2, lines 24-29).

See final office action mailed on September 21, 2005, p. 6.

In response to the final office action, Applicant continued to maintain the argument that the Schulz and Desmond references are not properly combinable. Applicant maintained that Schulz is directed to a switching mechanism for the exterior of a vehicle and does not teach or suggest being used with interior components. See Schulz Summary of the Invention and figures. Applicant further argued that Desmond showed only a manual push button interior rear view mirror illumination device. Desmond does not teach or suggest using a non-contact sensor or touch pad potentiometer to switch the lighting unit on and off. Applicant submitted additional evidence in the form of a Declaration of the inventor Volker Zipf who is a person of ordinary skill in the art. Mr. Zipf's Declaration was submitted to the Examiner in their response dated August 16, 2005.¹ Mr. Zipf's Declaration is first hand testimony of a person of ordinary skill in the art and his opinion on whether or not the two references would be properly combinable. Mr. Zipf's Declaration concluded that the two references would not be combinable to arrive at the claimed invention. See Appendix B, Declaration of Mr. Zipf ¶ 10. Applicant has continued to assert the evidence presented in Mr.

¹ This response was filed with an RCE. Subsequent Final Office Actions and Responses have been entered. The issue regarding obviousness has removed the same, that is, whether Schulz in view of Desmond are properly combinable. The Examiner has never countered Applicant's evidence regarding the ability to combine these two references.

Zipf's Declaration in all of their subsequent response. The Examiner offered no proof to rebut this evidence.

The advisory action before filing of an appeal brief responded to Applicants arguments maintaining that Applicant's position that the proposed combination of references is not obvious since the references fail to teach or provide motivation to combine them to obtain the claimed invention fails. The Examiner maintained that "...obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.**" [Citations omitted]. The Examiner went on further to note that there are three possible sources of motivation to combine the references "...the nature of the problem to be solved, the teachings of the prior art, and **the knowledge of persons of ordinary skill in the art.**" [Citations omitted]. The Applicant and the Examiner are at loggerheads regarding whether or not the references can be combined to arrive at the claimed invention.

The standard of obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior as a whole must suggest the desirability and, thus, the obviousness of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests

the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990). Furthermore it has been held that an absence of a teaching or suggestion in Skiver to illuminate the interior of the vehicle suggests that the Examiner has impermissibly used "hindsight" by using the Applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and to combine them as claimed. *In re In re Zirko* 111 F.3d 887, 42 USPQ 2d 1476 (Fed. Cir. 1997).

The Examiner has never countered any of the evidence set forth by the Applicant, but continues to maintain that Schulz in view Desmond are combinable to render the claimed invention obvious.

Evidence concerning the issue of whether or not the references relied upon by the Examiner, are properly combinable was presented in the Declaration of Mr. Volker Zipf. A copy of which is attached as Appendix B to this brief. Mr. Zipf has been working for Schefenacker Vision Systems Germany GmbH and Co. Kg. for over four years in the electronic development department. ¶ [0003] Appendix. B. Furthermore, Mr. Zipf has been listed as an inventor on several additional United States and German patents and/or applications relating to mirror and tail light development. Id. Thus Applicant submits that Mr. Zipf is

qualified to comment on the patentability of this case as being a person of ordinary skill in the art.

With regard to Schulz, Applicant maintains that this patent teaches or suggests a proximity switch being used in a door lock, Col. 3, Lines 30-34, and windshield wipers, Col. 4, Lines 62-64. See also Declaration ¶ 6. Claim 11 of the present invention contains a switching device for an interior mirror module. In support of this argument the attached declaration concludes that: “[m]y invention claims a switching device for an interior mirror module. The switching device is activated without touching a mechanical switch by having a sensor in the mirror housing...” Declaration ¶ 8. This is not the same as a proximity switch being placed in a door handle in order to unlock a door handle as taught by Schulz. This is also not the same as having a proximity switch on the exterior of a vehicle to detect water in order to activate the windshield wipers as taught by Schulz. Applicant further points out that all of the embodiments described in Schulz are for exterior automotive components and there is nothing to teach or suggest using the switching mechanism in the vehicle interior; nor is there anything that teaches or suggests associating the switching mechanism with a light.

The second reference, Desmond, discloses a rearview mirror light that is controlled by a mechanical switch. Declaration ¶ 7; Desmond Col. 1, Lines 25-30, 59-60. Claim 11 of the present invention contains a sensor where the switching process is activated by the approach of a non-metallic object. In support of this argument the attached declaration concludes: “[t]he sensor activates the switch when it detects a non-metallic object moving towards the sensor.” Declaration ¶ 8. This is not the same as a mirror housing having a mechanical switch that needs to be physically moved in order for the light to be

activated. It would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the manual switching device of Desmond to use the sensor as taught by Schulz. Declaration ¶ 10.

In summary, there is nothing in the Desmond patent that teaches or suggest a switching process based upon the approach of a non-metallic object toward at least one sensor as described in claim 11. Schulz teaches a proximity sensor for an exterior door handle or windshield wiper system, but does not teach suggest or motivate² one of ordinary skill in the art to use a switch of this type in a vehicle interior. Schulz also does not teach, suggest or motivate³ one of ordinary skill in the art to use the switches of Schulz in some kind of lighting device. Since the references do not teach, suggest or motivate, it can be concluded that the Examiner impermissibly used hindsight to arrive at the claimed invention.⁴ Furthermore, Desmond does not provide any motivation to combine the invention taught therein with the proximity sensor described in Schulz. Desmond only discloses a manual push button style switch. See Desmond Fig. 10.

As presented above, a person having ordinary skill in the art would not be motivated to combine the references in the manner suggested by the Examiner. The declaration of Mr. Zipf provides evidence that this combination of references cannot be used to render the invention obvious at the time of the invention.

² *In re Geiger* 815 F.2d at 688, 2 USPQ2d at 1278 (Fed Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital* 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

³ *Id.*

⁴ It has been held that an absence of a teaching or suggestion in *Skiver* to illuminate the interior of the vehicle suggests that the Examiner has impermissibly used "hindsight" by using the Applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and to combine them as claimed. *In re Zirko* 111 F.3d 887, 42 USPQ 2d 1476 (Fed. Cir. 1997).

Applicant now respectfully requests the removal of the rejection of independent claim 11.

Whether Claim 12 is rendered Obvious under 35 U.S.C. § 103(a)

Applicant further believes that dependent claim 12 is not rendered obvious by the proposed combination of Schulz in view of Desmond. Claim 12 requires that the evaluation electronics unit generates a turn on signal from a first approach and generates a turn off signal from a second approach. The Examiner maintains that Schulz teaches or suggests this figure at col. 4, lines 54-59. Applicant respectfully disagrees. In its entirety the specification of Schulz states:

When used in a locking control system, the capacitive proximity switch circuit is activated, thereby locking or unlocking a door, when a user's hand approaches the operating electrode of the circuit. One important feature of the invention is that the switching state of the circuit is unchanged when the user removes her hand from vicinity of the operating electrode. See Schulz Col. 4, lines 53-59.

Applicant maintains that the above passage, relied upon by the Examiner does not teach or suggest a switching device having an evaluation electronics unit that generates a turn on from first approach and generates a turn off signal from a second approach as set forth in Claim 12. Instead, the above section of Schulz only teaches the evaluation electronics unit generating a lock or unlock signal upon the approach of a user's hand to the operating electrode of the circuit. Schulz does not teach or suggest the evaluation electronics unit generating a turn on signal, nor does Schulz teach or suggest a turn off signal being generated by a second approach. Schulz teaches just the opposite. As cited above the specification of Schulz teaches that the "switching state of the

circuit is unchanged when the user removes her hand from the vicinity of the operating electrode". Thus, in order to apply in the present case, the act of the user removing their hand from the operating electrode would be a second approach that would generate a turn off signal such as claimed in the present invention, however, Schulz teaches that the circuit will remain unchanged, in fact teaching away from the present invention.

Desmond does not teach or suggest the limitations set forth in claim 12 of the present application. Desmond is directed to a manual push button switch, therefore, there is nothing in the specification of Desmond that would teach or suggest a turn on signal being generated from a first approach and a turn off signal being generated from a second approach. For these reasons we believe that claim 12 of the present application would be allowable and that the Examiner's combination of references relied upon are improper since it does not render the present invention obvious.

Whether Claim 20 is rendered Obvious under 35 U.S.C. § 103(a)

Claim of the present application states "...wherein said at least one sensor is provided with a sensitivity adjustment that is used to set the length of the desired approach distance." The Examiner maintains that Fig. 1 of Schulz teaches or suggests this limitation. Fig. 1 of Schulz is a schematic diagram with a capacitive proximity switch used as an actuating element in accordance with the embodiments of the invention. See Schulz, brief description of drawings section. The specification described various operating electrodes having specific capacitance. See col. 3, lines 20-34. Schulz does not teach or suggest the various electrodes functioning as a sensor, much less at least one sensor.

Additionally, there is nothing in Fig. 1 that teaches or suggests adjusting the sensitivity. Applicant further maintains that the sensitivity of the various electrodes shown in Fig. 1 could potentially vary depending on external environmental factors. For example, static electricity build up from the outside environment could effect the sensitivity of the various electrodes shown in Fig. 1 of Schulz. Applicant further notes that Desmond does not resolve this deficiency since Desmond only teaches or suggests a manual push button switch for the interior mirror module.

Whether Claim 22 is rendered Obvious under 35 U.S.C. § 103(a)

Applicant also maintains that the proposed combination of references when combined do not render claim 22 of the present application obvious. Claim 22 requires at least one sensor located in the lower corner region of the housing facing a driver. The Examiner relied upon the Desmond reference to teach or suggest this limitation. Applicant further notes that Schulz does not teach or suggest a switch arrangement for an interior mirror module, much less a sensor located in the lower corner region of the housing facing a driver. With regard to Desmond Applicant notes that the Examiner relied upon Fig. 1 of the drawings to teach or suggest this limitation. Fig. 1 of Desmond shows a mirror assembly (10) having a mirror case (11). See Desmond at col. 3, lines 53-55. On the bottom (24) of the case (11) switches (27) and (29) are positioned for operating the lamp assemblies. See Desmond at col. 4, lines 38-41. The switches for the light assemblies as shown in Fig. 1 are located in the central bottom portion of the mirror case 11. Applicant maintains that Desmond does not teach or suggest having at least one sensor located in the lower corner region of the housing

facing a driver. To the contrary Desmond teaches or suggests having the switches (27, 28) located on the bottom (24) of the casing (11). For this reason, Applicant maintains that the proposed combination of references cited by the Examiner do not render obvious claim 22 of the present application.

Conclusion

In conclusion the above arguments demonstrate that the proposed combination of Schulz in view of Desmond do not render obvious the present claim set. The two references are not combinable as Schulz teaches or suggests a capacitive proximity switch for use on exterior automotive features such as door handles and windshield wipers. There is nothing in Schulz that teaches or suggests using the capacitive proximity switch in the vehicle interior, much less in combination with operating a light module. With regard to Desmond, Applicant maintains that Desmond provides no motivation for substituting the manual push button switch mechanisms with a non-contact sensor as recited in the claims of the present application. For these reasons Applicant asserts that the proposed combination of references is not proper and the Examiner must have impermissibly used "hindsight" by using the Applicants teaching as a blueprint to hunt through the prior art for the claimed elements and to combine as claimed. *In re Zirko*, 111 F.3d 887, 42 USPQ 2d 1476 (Fed. Cir. 1997). Additionally, with regard to claims 12 and 20 Applicant notes that both Schulz and Desmond do not teach or suggest the limitation of an evaluation electronics unit generating a turn on signal from a first approach and a turn off signal from a second approach. The specification and drawings of Schulz do not teach or suggest this, nor does the specification and drawings of Desmond. With regard to claim 20 Applicant

maintains that Schulz in view of Desmond does not teach or suggest at least one sensor having a sensitivity adjustment. Desmond does not teach or suggest the use of a sensor for operating a light module.

Appendix Contents

Attached to the end of this Brief is an Appendix A which contains a copy of the current pending claims that are subject to this appeal. Appendix B is an Evidence Appendix that contains a copy of the Declaration of Volker Zipf which was entered into this case in Applicants response filed on August 16, 2005. Appendix C is the Related Related Proceedings Appendix

Please send all future correspondence relating to this application to Warn, Hoffmann, Miller & LaLone, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

WARN, HOFFMANN, MILLER & LALONE, P.C.
Attorneys for Applicant(s)

Dated: *October 6, 2006*

By: *Philip R. Warn*
Philip R. Warn, Reg. No. 32775
Gregory L. Ozga
Gregory L. Ozga, Reg. No. 53425

P.O. Box 70098
Rochester Hills, MI 48307
(248) 364-4300

PRW:GLO:cah

Claims Appendix

Claims 1-10 (Cancelled)

Claim 11. (Previously Presented) A switch arrangement for an automotive interior mirror module comprising:

- a mirror housing of an automotive interior mirror module;
- at least one sensor disposed in said mirror housing; and
- an evaluation electronics unit disposed in said mirror housing and operably associated with said at least one sensor, wherein said evaluation electronics unit initiates at least one switching process based on the approach of a non metallic object toward said at least one sensor.

Claim 12. (Previously Presented) The switching device of claim 11 wherein the evaluation electronics unit generates a turn-on signal from a first approach and generates a turn-off signal from a second approach.

Claim 13. (Previously Presented) The switching device of claim 12 further comprising a reading lamp integrated in said housing is turned on and off by the turn-on and turn-off signals.

Claim 14. (Previously Presented) The switching device of claim 11 wherein the automotive interior mirror module has a mirror base.

Claim 15. (Previously Presented) The switching device of claim 14 wherein the evaluation electronic unit is located in said mirror base.

Claim 16. (Previously Presented) The switching device of claim 15 wherein said evaluation electronic unit is an external evaluation electronics unit located externally from said mirror housing or said mirror base.

Claim 17. (Previously Presented) The switching device of claim 11 wherein said evaluation electronics unit is located in said housing.

Claim 18. (Previously Presented) The switching device of claim 11 wherein said at least one sensor is a sensor array.

Claim 19. (Previously Presented) The switching device of claim 11 wherein the sensor is provided with a preferred directivity.

Claim 20. (Previously Presented) The switching device of claim 11 wherein said at least one sensor is provided with a sensitivity adjustment that is used to set the length of the desired approach distance.

Claim 21. (Previously Presented) The switching device of claim 11 wherein said evaluation electronics unit initiates said at least one switching process based on the force-free touch of a non metallic object as a switching element.

Claim 22. (Previously Presented) The switching device of claim 11 wherein said at least one sensor is located in the lower corner region of said housing facing a driver.

Claim 23. (Cancelled)

Evidence Appendix

The Volker Zipf was submitted under 37 C.F.R. §132. The Examiner acknowledged receipt and consideration of this Declaration on page 8 of the Office Action mailed on September 21, 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/607,923
Filing Date: June 27, 2003
Applicant: Helmut Bentivoglio and Volker Zipf
Group Art Unit: 2875
Examiner: Ismael Negron
Title: PROXIMITY SWITCH FOR AUTOMOTIVE INTERIOR
MIRROR MODULE
Attorney Docket: SCH-00069

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 CFR §132

Sir:

VOLKER ZIPF (Please print your name) declares as follows:

1. I am the inventor of the subject matter of the above identified patent application.

2. I received a Dipl. Ing (FH) from
Fachhochschule ESSLINGEN - University of Applied Sciences
(Please fill in your educational background, i.e., degrees and what institution you received them from).

3. I have been employed with Schefenacker Vision Systems Germany GmbH & Co. KG for the past 4 years working in electronic development ^{department}. (Please fill in the areas in which you have worked in at Schefenacker Vision Systems). My working life has been spent in the electronic development. (Please fill

In the areas in which you have worked prior to working at Schefenacker Vision Systems). I am listed as an inventor on the following

patent(s) US 11/043402, US 6825420, DE 10338398

relating

to

MIRROR AND TAILLIGHTS DEVELOPMENT

4. I have reviewed the Examiner's Final Office Action mailed on February 17, 2005, and U.S. Patent No. 5,880,538 issued to Schulz (hereafter the '538 patent) and U.S. Patent No. 5,820,245 issued to Desmond (hereafter the '245 patent) which were used as a basis for rejecting all pending claims in the application.

5. After reviewing the '538 patent, the '245 patent, and the reasoning for the rejection of claims 11-23 under 35 USC §103(a) as set forth in the Final Office Action, I conclude that this rejection is not proper.

6. The '538 patent discloses an actuating device for exterior automotive control devices, such as door locks and windshield wipers. The actuating device is a contact or proximity switching mechanism that is switch by non-mechanical means. Col. 3, Lines 7-9. The '538 patent describes the actuating device being activated by a person approaching the switch that is located in the automobile's door handle in order to unlock the door. Col. 3, Lines 30-34. The '538 patent also describes the actuating device being used to activate an automobile's windshield wipers when water approaches the device. Col. 4, Lines 62-64.

7. The '245 patent discloses an interior rearview mirror with a light that is controlled by a mechanical switch that is in the mirror housing. Col. 1, Lines 25-30, 59-60 and Col. 2, Lines 26-30. Figure 9 of the '245 patent depicts mechanical switches (27) and (29) which are used to operate the lamp assemblies. Figure 9 also shows mechanical switch (28) which is used to operate the mirror and the LED.

8. My invention claims a switching device for an interior mirror module. The switching device is activated without touching a mechanical switch by having a sensor

in the mirror housing that is connected to internal evaluation electronics. The sensor activates the switch when it detects a non-metallic object moving towards the sensor.

9. The Final Office Action at ¶ 3 indicates that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine the non-contact switch of the '538 patent with the vehicle illumination device of the '245 patent.

10. I respectfully disagree that one of ordinary skill in the art at the time the invention was made would be motivated to modify the manual switch of the '245 patent with the switch in the '538 patent. The combined teachings of the '538 and '245 patents fail to teach, suggest or motivate placing a switching device based upon the approach of a non-metallic object toward a sensor for use in an interior mirror module. Being an individual who is skilled in the area of automotive control devices I profess that the proposed combination of the references would not be obvious. Moreover, one of ordinary skill in the art at the time of the invention was made would not be motivated to place the '538 switch inside a mirror housing.

12. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-referenced application or any patent issuing thereon.

Date: 8.8.05

By: Volker Zipf
(Signature)

VOLKER ZIPF
(Please print name)

Related Proceedings Appendix

NONE